

DOCKET NO: 9849-0002-22 REISSUE

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

IN RE REISSUE APPLICATION OF: :

U.S. PATENT 5,098,893 :

FRANKS ET AL :

SERIAL NO: NEW REISSUE APPLICATION :

FILED: HEREWITH :

FOR: STORAGE OF MATERIALS

**ASSENT OF ASSIGNEE, UNDER 37 C.F.R. §1.172**

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

SIR:

Inhale Therapeutics, the Assignee of the entire right, title and interest, based on my review of the a papers assigning said interest, does hereby assent to the above-captioned Reissue Application. I have full authority to give such assent.

All statements made herein of my own knowledge are true and all statements made on information and belief are believed true. I am aware that willful false statements and the like are punishable by fine, imprisonment, or both pursuant to 18 USC 1001, and that such willful false statements may jeopardize the validity of U.S. Patent 5,098,893, the above-captioned Reissue Application, and any patent issuing thereon.

CERTIFICATION UNDER 37 C.F.R. 3.73 (b)

I, the undersigned, certify that I am an individual empowered to act on behalf of Inhale Therapeutics the assignee of the entire right, title and interest of the above-captioned application by virtue of an assignment from the inventors(s) of said application.

I further certify that I have reviewed all the documents in the chain of title of the patent application identified above, that the Assignment has been recorded in the U.S. Patent and Trademark office at reel no. 8783, frames 0704, that I have reviewed the Assignment recorded at said reel and frame, and that to the best of my knowledge and belief title is in the above-noted assignee.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information belief are believed to be true; and further that these statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States code and that such willful false statement may jeopardize the validity of this application or any patent issuing thereon.

  
\_\_\_\_\_  
Signature

Stephen L. Hurst  
\_\_\_\_\_  
Name (Typed)

*General Counsel*  
\_\_\_\_\_  
Office or Title

28  
**FILED** 10/10/2000

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:  
FELIX FRANKS ET AL

: EXAMINER: RUSSEL

SERIAL NO. 09/270,791

:

FILED: MARCH 17, 1999

: GROUP ART UNIT: 1654

FOR: STORAGE OF MATERIALS

SECOND SUPPLEMENTAL

37 CFR 1.175 REISSUE DECLARATION BY THE ASSIGNEE

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

SIR:

**I. 37 CFR 1.172 Declaration by the Assignee**

1. The written consent to this reissue application by the assignee owning an undivided interest in the patent that was previously filed in this reissue application. The reissue application does not seek to enlarge the scope of the claims of the original patent. The assignee has established their ownership interest in the patent by filing a submission in accordance with the provisions of 37 CFR 3.73(b).

**II. 37 CFR 1.175**

**A. 37 CFR 1.175(a)**

2. This declaration is executed in accordance with 37 CFR 1.68. Specifically, the undersigned has been warned that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001), and willful false statements may jeopardize the validity

of this application or any patent issuing thereon. All of the undersigned's statements based upon personal knowledge are true, and all of the undersigned's statements made on information and belief are believed to be true.

1. **37 CFR 1.63(a)(2)**

3. This declaration is directed to the specification for application serial No. 09/270,791, which is an application to reissue the 5,098,893 patent to Franks et al.

2. **37 CFR 1.63(a)(3)**

4. There are two inventors.

5. The full name of the first inventor is Felix Franks. Felix Franks' residence, Post Office address is 7 Wootton Way, Cambridge CB39LX, United Kingdom. Felix Franks is a citizen of the United Kingdom.

6. The full name of the second inventor is Ross H. M. Hatley. Ross Hatley's residence, Post Office address is 47 Fen End, Willingham, United Kingdom. Ross Hatley is a citizen of the United Kingdom.

3. **37 CFR 1.63(a)(4)**

7. Felix Franks and Ross Hatley are joint inventors of the inventions claimed.

4. **37 CFR 1.63(b)(i)**

8. I have reviewed and I understand the contents of the specification, including the claims, as proposed to be amended upon filing, and as proposed to be amended with a response being filed concurrently with this declaration.

5. **37 CFR 1.63(b)(2)**

9. I believe the named inventors to be the original and first inventors of the subject matter which is claimed and for which a patent is sought.

6. **37 CFR 1.63(b)(3)**

10. I acknowledge the duty to disclose to the Office all information known to me to be material to patentability as defined in 37 CFR 1.56.

7. **37 CFR 1.63(c)**

11. The foreign application is United Kingdom application No. 8903593 filed February 16, 1989. Priority is claimed from that application.

8. **37 CFR 1.63(d)**

12. This section is inapplicable.

9. **37 CFR 1.63(e)**

13. This section is inapplicable.

B. **37 CFR 1.175(a)(1)**

14. I believe the original patent to be wholly or partly inoperative or invalid by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, and I rely upon the statement of the error in the originally filed reissue application which is:

In original claim 12, a method claim, with a phrase "and forming the resulting mixture into a glassy amorphous state" arguably encompasses removing water from the mixture by sublimation, also known as freeze drying.

C. **37 CFR 1.175(a)(2)**

15. All errors being corrected in the reissue application arose without any deceptive intention on the part of the applicant.

III. **37 CFR 1.175(b)**

16. Every error addressed by the claims filed with this declaration arose without any deceptive intention on the part of the applicant.

IV. **37 CFR 1.175(c)**

17. This section provides no additional requirements.

V. **37 CFR 1.175(d)**

18. This section is inapplicable.

IV. **Jurat**

19. I declare under penalty of perjury of the laws of the United States that the foregoing is true and correct.

October 5, 2000

Date



Stephen L. Hurst  
General Counsel, Inhale Therapeutic Systems

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9849-0002-22 REISSUE

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

FELIX FRANKS ET AL

: EXAMINER: RUSSEL

SERIAL NO. 09/270,791

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FILED: MARCH 17, 1999

: GROUP ART UNIT: 1654

FOR: STORAGE OF MATERIALS

37 CFR 1.175 REISSUE DECLARATION BY THE ASSIGNEE

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

SIR:

I. 37 CFR 1.172 Declaration by the Assignee

1. The written consent to this reissue application by the assignee owning an undivided interest in the patent that was previously filed in this reissue application. The reissue application does not seek to enlarge the scope of the claims of the original patent. The assignee has established their ownership interest in the patent by filing a submission in accordance with the provisions of 37 CFR 3.73(b).

II. 37 CFR 1.175

A. 37 CFR 1.175(a)

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V. 37 CFR 1.175(d)

18. This section is inapplicable.

IV. Jurat

19. I declare under penalty of perjury of the laws of the United States that the foregoing is true and correct.

3-8-00

Date



Stephen L. Hurst  
General Counsel, Inhale Therapeutic Systems

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**REISSUE APPLICATION  
DECLARATION BY THE ASSIGNEE**

Docket Number

9849-0002-22 REISSUE

I hereby declare that:

My residence, post office address and citizenship are stated below next to my name.

I am authorized to act on behalf of the following

company:

INHALE THERAPEUTICS

and the title of my position within said company is:

The entire title to the patent identified below is vested in said company.

Name of Patentee(s)

**FRANKS ET AL**

Patent Number

5,098,893

Date Patent Issued

**MARCH 24, 1992**

Title of Invention

**STORAGE OF MATERIALS**

I believe said patentee(s) to be the original, first and sole or joint inventor(s) of the subject matter with is described and claimed in said patent, for which a reissue patent is sought on the invention entitled:

the specification of which

☒ is attached hereto

☐ was filed on \_\_\_\_\_ as reissue application number \_\_\_\_\_

and (if applicable) was amended on \_\_\_\_\_

I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.

We (I) hereby claim foreign priority benefits under 35 USC §119(a)-(d) or §365(b) of any foreign application(s) for patent or inventor's certificate, or §365(a) of any PCT International application which designated at least one country other than the United States, listed below and have also identified below any foreign application for patent or inventor's certificate, or PCT international application having a filing date before that of the application on which priority is claimed. Prior Foreign Application(s):

**Application No.**

**Country**

**Day/Month/Year**

**Priority  
Claimed**

8903593

Great Britain

16 February 1989

Yes

We (I) hereby claim the benefit under 35 USC §119(e) of any United States *provisional* application(s) listed below.

**Application Number**

**Filing Date**

We (I) hereby claim the benefit under 35 USC §120 of any United States application(s), or §365(c) of any PCT International application designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application in the manner provided by the first paragraph of 35 USC §112, I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR §1.56 which became available between the filing date of the prior application and the national or PCT International filing date of this application.

**Application Serial No.**

**Filing Date**

**Status**

I verily believe the original patent to be wholly or partly inoperative or invalid, for the reasons described below.  
(Check all that apply)

☐ by reason of a defective specification or drawing.

☒ by reason of the patentee claiming more or less than he had the right to claim in the patent.

☐ by reason of other errors.

At least one error upon which reissue is based is described as follows:

In original claim 12, a method claim, where the phrase "and forming the resulting mixture into a glassy amorphous state" arguably encompasses removing water from the mixture by sublimation, also known as freeze drying. The method claims clearly distinguish the prior art by reciting that water is removed by "evaporation of liquid water".

All errors corrected in this reissue application arose without any deceptive intention on the part of the applicant.

**REISSUE APPLICATION  
OFFER TO SURRENDER PATENT**

Docket Number

9849-0002-22 REISSUE

This is part of the application for a reissue patent based on the original patent identified below.

Name of Patentee(s)

FRANKS ET AL

Patent Number

5,098,893

Date Patent Issued

MAY 24, 1992

Title of Invention

STORAGE OF MATERIALS

I am the Assignee of the original patent.

I offer to surrender the original patent.

One box  
must be  
checked

☒ Filed herein is a certificate under 37 CFR 3.73(b).

☐ Ownership of the patent is in the inventor(s), and no assignment of the patent has been made.

The written consent of all assignees owning an undivided interest in the original patent is included in this application for reissue.

Signature

Date

Typed or printed name of person signing for assignee

Stephen L. Hurst

The assignee owning an undivided interest in said original patent is: INHALE THERAPEUTICS

and the assignee consents to the accompanying application for reissue.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine and imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this declaration is directed.

Name of assignee

INHALE THERAPEUTICS

Signature of person signing for assignee

Date

Typed or printed name of person signing for assignee

Stephen L. Hurst

Reissue Application Declaration by the Assignee (Continued)

I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected herewith: Norman F. Oblon, Reg. No. 24,618; Marvin J. Spivak, Reg. No. 24,913; C. Irvin McClelland, Reg. No. 21,124; Gregory J. Maier, Reg. No. 25,599; Arthur I. Neustadt, Reg. No. 24,854; Richard D. Kelly, Reg. No. 27,757; James D. Hamilton, Reg. No. 28,421; Eckhard H. Kuesters, Reg. No. 28,870; Robert T. Pous, Reg. No. 29,099; Charles L. Gholz, Reg. No. 26,395; Vincent J. Sunderdick, Reg. No. 29,004; William E. Beaumont, Reg. No. 30,996; Steven B. Kelber, Reg. No. 30,073; Robert F. Gnuse, Reg. No. 27,295; Jean-Paul Lavalle, Reg. No. 31,451; Stephen G. Baxter, Reg. No. 32,884; Martin M. Zoltick, Reg. No. 35,745; Robert W. Hahl, Reg. No. 33,893; Richard L. Treanor, Reg. No. 36,379; Steven P. Weihrouch, Reg. No. 32,829; John T. Goolkasian, Reg. No. 26,142; Marc R. Labgold, Reg. No. 34,651; Richard L. Chinn, Reg. No. 34,305; Steven E. Lipman, Reg. No. 30,011; Carl E. Schlier, Reg. No. 34,426; James J. Kulbaski, Reg. No. 34,648; Catherine B. Richardson, Reg. No. 39,007; Richard A. Neifeld, Reg. No. 35,299; J. Derek Mason, Reg. No. 35,270; and Surinder Sachar, Reg. No. 34,423, Felissa H. Cagan, Reg. No. 35,089  
Stephen L. Hurst, Reg. No. 31,266, Susan T. Evans, Reg. No. 38,443

Correspondence Address:  
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Fourth Floor

1755 Jefferson Davis Highway  
Arlington, Virginia 22202.

Telephone: (703) 413-3000

Facsimile: (703) 413-2220

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine and imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this declaration is directed.

Full Name of Person Signing (given name, family name)

Signature Stephen L. Hurst Date 3/12/99

Residence \_\_\_\_\_ Citizenship \_\_\_\_\_

Post Office Address \_\_\_\_\_

(OSMMN 10/98)